



**UNITED STATES DEPARTMENT OF COMMERCE**  
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/557,376      | 04/25/00    | BORMANN              | A BEIERSDORF 6      |

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HM22/0102

EXAMINER

WELLS, L

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

*2*  
01/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.

09/557,376

Applicant(s)

BORMANN ET AL.

Examiner

Lauren Q Wells

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-9 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### *Election/Restrictions*

Claims 1-9 drawn in Markush format, encompass multiple independent and patentably distinct inventions. Accordingly, a requirement to provisionally elect a single independent and patentably distinct species is made as provide for in MPEP § 803.02. It is noted that the claims encompass such final products as those set forth in Examples 1-9.

It is considered that a Markush-type claim encompassing such species is directed to multiple independent and patentably distinct inventions since the species are so unrelated and diverse that a reference anticipating one of the species would not anticipate or render obvious the other species. Further, the species are considered to be independent since they are unrelated in operation, one does not require the other for ultimate use, and the specification does not disclose a dependent relationship between them. Moreover, each of the stated species is considered to be patentably distinct from the others on the basis of its properties. Thus, the stated species are capable of supporting separate patents under 35 USC § 121.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election. By species is meant a single compound. The compound may be named in any of four ways (or any combination thereof): 1) according to the IUPAC standard, 2) by a pictorial representation of the compound, 3) by setting forth the specific chemical group that each variable of the Markush group represents, or 4) by naming a claim or an example which itself sets forth a single compound.

Since the instant claims are drawn to a composition of matter which contains more than one group of compounds, a single compound (as described above) should be elected for each group of compounds. It is not necessary to elect a single compound for groups of compounds which are inert and have no bearing on the patentability of the composition (e.g. it would not usually be necessary to elect which solvent or buffer system the composition will be associated with). **In the instant case, applicant should elect a composition, wherein a particular compound is chosen for part "a", part "b", and part "c" of the composition.**

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.C.C. § 103 of the other invention.

In the event that the Markush-type claims are not found to be allowable the examination of the claims presented will be limited to the Markush-type claims to the extent that they read on the elected species and claims directed solely to the elected species. The claims directed solely to the non-elected species will be held withdrawn from consideration. A requirement to elect a species has been held to be tantamount to a requirement for restriction under 35 USC § 121<sup>1</sup>.

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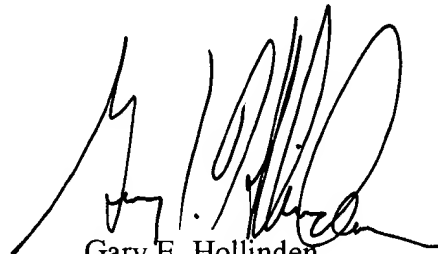
<sup>1</sup> In re Herrick, 115 USPQ, Comm'r Pat.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary E Hollinden can be reached on (703) 308-4521. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

A handwritten signature in black ink, appearing to read 'G. E. Hollinden', is written over the printed name.

Gary E. Hollinden  
Primary Examiner  
Art Unit 1619

lqw  
November 22, 2000